

REMARKS

I. Status of the Claims

Claims 1-47 are currently pending. No claims are amended herein.

II. Rejections Under 35 U.S.C. § 103

1. Claims 1-32, 34-41, and 43-47

Claims 1-32, 34-41, and 43-47 were rejected over Decoster WO 97/46210, with the Office relying on U.S. Patent No. 6,451,747 as a English language translation ("the '747 patent" or "Decoster '210") in view of an English language translation of Decoster WO 97/46211. (Office Action, pg. 2.) For the purpose of this response, Applicants are relying on U.S. Patent No. 6,153,570 ("the '570 patent" or "Decoster '211") as an English language equivalent of Decoster WO 97/46211. Applicants respectfully traverse for at least the following reasons.¹

a) The Office has already recognized that the references do not disclose an aminated silicone according to the presently claimed invention

In the Office Action dated November 10, 2003, the Office recognized that Decoster '211 lacks, among other things, an aminated silicone according to the presently claimed invention. (Office Action dated November 10, 2003, pg. 6.) Indeed, the amine-containing silicone of formula (I) in Decoster '211 is structurally distinct from the formulae of the presently claimed aminated silicones.

¹ Applicants further note that the present rejections are based on combinations of references previously relied upon by the Office. By presenting new combinations of references previously considered and traversed, the Office is engaging in the type of "piecemeal examination" that the MPEP instructs "should be avoided as much as possible." MPEP § 707.07(g).

In the present Office action, the Office similarly recognizes that Decoster '210 lacks, among other things, an aminated silicone according to the presently claimed invention. (Office Action dated February 8, 2005, pg. 3.) In particular, Decoster '210 discloses several generic aminated silicone formulae, but does not teach or suggest an aminated silicone having an amine number as claimed.

Thus, based on the Office's own characterizations, no combination of Decoster '210 and Decoster '211 will achieve a composition or process within the scope of the presently claimed invention. Accordingly, the reference combination fails to support a prima facie case. MPEP § 2143.03.

b) There would have been no motivation to modify Decoster '210 in view of Decoster '211 as proposed by the Office.

The Office's first argument for modifying or combining the references is that

[i]t would have been obvious . . . to substitute the amodimethicone exemplified in '747 for the compounds of [claimed] Formulas (I), (IV) or (II) of the instant invention because the precise formulas of these compounds are specifically taught by '747 to be aminosilicones useful in the invention taught therein.

(Office Action dated February 8, 2005, pg. 4.)² However, even if Decoster '210 (the '747 patent) discloses a genus of amodimethicones that could contain an aminated silicone according to the presently claimed invention "having an amine number greater than or equal to 0.4 meq/g," a genus does not anticipate all species therein, without

² Applicants note that, as formulated by the Office, this argument depends only on Decoster '210 (the '747 patent), which has already been successfully traversed. (See rejection in Office Action of July 28, 2004, not repeated in Office Action of February 8, 2005.) Accordingly, consistent with its previous determination, the Office should drop this argument as justification for the present rejection.

motivation to direct one of skill in the art to those species. MPEP § 2144.08(II)(A)(4) ("Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus."); *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.").

The Office has not provided and cannot provide factual support for the motivational determination required by the MPEP and case law. Indeed, the references do not provide any motivation to select undisclosed amodimethicones according to one of the recited formulae having any particular amine number, much less an amine number as claimed. The Office responded to Applicants' remarking in the Response of October 27, 2004, by stating only that they "have been considered but are moot in view of the new ground(s) of rejection." (Office Action of February 8, 2005, pg. 7.) However, Applicants' response specifically addressed the impropriety of the Office attempting to rely on the disclosure of an amodimethicone generally to reject claims reciting amodimethicone having a specified amine number requirement. This discussion is relevant to the current rejection, and is hereby incorporated. (See Response of October 27, 2004, pgs. 2-5.) The Office is, therefore, respectfully requested to reconsider those remarks in the context of the present rejections.³

³ Should the present rejection be maintained, or should any new rejection over Decoster '210 be made, the Office is requested to respond specifically and expressly to each of the points raised in the incorporated response. (See, e.g., MPEP § 707.07 ("The examiner must, however, address any arguments presented by the applicant (continued...)

The Office's second argument for modifying or combining the references is that

[i]t would have been obvious . . . to exemplify an amodimethicone of Formula's (I), (IV) or (II) of the instant invention with an [amine number] meq/g of 0.5 because (1) both '747 and '211 teach detergent cosmetic compositions for hair care; (2) both '747 and '211 teach a composition comprising a washing base and a conditioning system wherein the conditioning system comprises at least one cationic polymer and an aminosilicone; and (3) '211 teaches that the aminosilicone should be formulated such that the meq/g is 0.5 meq/g. [4] One would have been motivated to formulate the aminosilicone to have an meq/g of 0.5 because of an expectation of success in preparing a detergent cosmetic composition, as taught by '747.

(Office Action dated February 8, 2005, pg. 5.) What the Office appears to be trying to argue here is that it can select an amine number from one end of a range for a specific type of silicone according to Decoster '211 and apply this amine number (but not the actual silicone) to a distinct silicone according to Decoster '210, absent any specific teaching, suggestion, motivation, or reasonable expectation of success. This is improper, and Applicants respectfully disagree for at least the following reasons.

Preliminarily, there is a fundamental flaw in the entirety of the proposed modification/combination. If there would have been any motivation based on Decoster '211 to use an aminosilicone in Decoster '210, the only rational argument would be to use the aminosilicone actually disclosed in Decoster '211 in a composition or process according to Decoster '210.⁴ However, as the Office has recognized, Decoster '211

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which are still relevant to any references being applied."); MPEP § 707.07(f) ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.")

⁴ Applicants do not necessarily agree that there would have been a motivation for even this combination. The point is, instead, that this would be a more rational proposal
(continued...)

does not disclose an aminated silicone as recited in the present claims. Thus, as noted in section a) above, no combination of Decoster '210 and Decoster '211 will achieve a composition or process within the scope of the presently claimed invention.

With respect to the Office's point no. (1), that "both '747 and '211 teach detergent cosmetic compositions for hair care," Applicants submit that this is not a motivation to select undisclosed amodimethicone species according to one of the recited formulae having an amine number as claimed. Similarly, the Office's point no. (2), that "both '747 and '211 teach a composition comprising a washing base and a conditioning system wherein the conditioning system comprises at least one cationic polymer and an aminosilicone," is also not a motivation to select undisclosed amodimethicone species according to one of the recited formulae having an amine number as claimed. The possibility that two references may have, when broadly defined, common general features is not sufficient to establish a motivation to combine these references.

The Office's point no. (3), that "'211 teaches that the aminosilicone should be formulated such that the meq/g is 0.5," is factually incorrect as stated without further qualification. Further, it is also not a motivation to select undisclosed amodimethicone species according to one of the recited formulae having an amine number as claimed. Rather than teaching or suggesting that any aminosilicones *generally* "should be formulated such that the meq/g is 0.5" (Office Action of February 8, 2005, pg. 5), according to the '570 patent (Decoster '211), a specified amine containing silicone is

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than the position taken by the Office. Moreover, there certainly would have been no motivation based on Decoster '211 to use an aminated silicone other than those disclosed therein.

disclosed to have an amine number of between 0.01 and 1 meq/g. ('570 patent, col. 2, ln. 3-35, formula (5); see also abstract; claim 1.) While example composition A of Decoster '211 is disclosed as having an amine number of approximately 0.5 meq/g, there is no express disclosure that this is the amine number that should be used in all cases or in all applications. Indeed, an amine number as low as 0.01 may be used. ('570 patent, col. 2, ln. 33-35.)

Further, there is no basis to extrapolate the conditions in Decoster '211 to other silicones in other compositions. Indeed, there is no disclosure that any or all amine-containing silicones having formulae distinct from Decoster '211 should have the same or even similar amine numbers, especially when used in compositions distinct from those of Decoster '211. Moreover, in making the proposed modification of Decoster '210, the Office attempts to override the apparent preference in Decoster '210 for amine-containing silicones having an amine number of <0.1 meq/g, such as Fluid DC 939, as disclosed in Example 1 and 2 ('747 patent, col. 20, line 10 - col. 21, line 23). There is, however, no basis to give more weight to the inconsistent amine number of 0.5 meq/q taken out of context from Decoster '210.

The Office's point no. (4), that "[o]ne would have been motivated to formulate the aminosilicone to have an meq/g of 0.5 because of an expectation of success in preparing a detergent cosmetic composition, as taught by '747" is circular. The alleged motivation is premised on an unsupported reasonable expectation of success. Neither a reasonable expectation of success nor a motivation has been supported by any evidence of record. Further, this boot-strap argument, where an expectation of success is the basis of the motivation, ignores the fact that motivation and reasonable

expectation of success are distinct requirements. MPEP § 2143. The Office must show *both* from evidence of record in order to establish a prima facie case of obviousness. One unsupported element cannot serve as the foundation for another.

2. Claims 33 and 42

Claims 33 and 42 were rejected over Decoster '210 and Decoster '211, in further view of Naito, U.S. Patent No. 5,476,649 ("the '649 patent"). Applicants respectfully traverse for at least the reasons discussed above and previously on the record with respect to the '649 patent. Further, the rejection is flawed since the '649 patent has not been cited for and does not overcome the deficiencies of Decoster '210 and Decoster '211. In addition, the Office has failed to cite any evidence of a motivation for the proposed combination, instead relies on a circular and legally flawed argument wherein a factually unsupported expectation of success is relied upon in the absence of affirmative evidence of a motivation.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.


The Examiner is respectfully invited to contact Applicants' undersigned representative by telephone, at (202) 408-4092, to discuss this case.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Mark J. Feldstein
Reg. No. 46,693